



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,958	08/18/2006	Yuichi Idehara	1163-0579PUS1	1060
2292 7590 12/31/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
VO, CECILE H				
ART UNIT		PAPER NUMBER		
2169				
NOTIFICATION DATE		DELIVERY MODE		
12/31/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/589,958

Applicant(s)

IDEHARA ET AL.

Examiner

CECILE VO

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/2008 has been entered.
2. Claims 1-18 are pending as amended on October 21, 2008, with claims 1, 6, 7, 8, 10, 15, 16 and 17 being independent. Claims 1, 6, 7, 8, 10, 15, 16 and 17 are currently amended.

Duplicated Claims Objections

3. Claims 1 and 6 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

4. Claims 10 and 15 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-9 and 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 1-9 are directed to system comprising software per se. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and thus, is not a composition of matter. Therefore, software per se is not one of the four categories of invention.

In response to Applicant's argument to rejection of claims 1-9 under 35 USC 101, the applicant directs the examiner to pages 13 and 17 of the instant specification as

evidences of hardware. As admitted by the applicant, the "units" relate to both software and hardware. Thus, the "units" disclosed in the specification are not merely limited to hardware or software. However, no computer readable medium or other hardware is positively recited in the claim language to establish a statutory category or enable any functionality of the recited descriptive material to be realized. Therefore, the rejection of claims 1-9 under 35 USC 101 is maintained.

8. Claims 10, 15, 16 and 17 recite "[acquiring]", "[selecting]", "[generating]" and "[delivering]" which are not qualify as a statutory process because the claim does not transform underlying subject matter nor it is tied to another statutory class. To qualify as a statutory process, the claims should positively recites the other statutory class (e.g. the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state (see MPEP 2106.IV.B and 2106.IV.C; and also see *Diamond v. Diehr*, 450 U.S. at 175, 184 (1981); *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972); and also see in re *Stephen W. Comiskey*, 499 F.3d 1365; 2007 U.S. App. LEXIS 22414; 84 U.S.P.Q.2D (BNA) 1670).

Claims 11-14 and 18 are rejected for the same reason, due to their dependence on the above rejected claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinohara, US Patent Number 7,310,514 B2.

Regarding claim 1, Shinohara discloses a media delivering apparatus which delivers media data to a media receiving apparatus by way of a network, characterized in that said apparatus comprises:

a parameter acquiring unit for acquiring at least one of a communication capability of said network,(e.g. control console (as a *parameter acquiring unit*) performs through the operation of a user, the entry of various types of data or instructions enabling or preventing transmission of multimedia messages, col. 8, lines 24-27.

Shinohara further discloses: a transmission-origin mobile telephone can transmit a multi-media message after checking the processing capabilities of transmission-destination mobile telephones even when an external terminal is connected to a mobile telephone to extend the range of types and formats of multimedia messages that can be

received, col. 8, lines 64-67-col. 9, lines 1-3), and a receiving capability of said media receiving apparatus as a parameter (e.g. Wireless unit (as *a receiving capability*) performs transmission and reception of data with a base station that constitutes a part of network by way of wireless lines, for example by CDMA wireless communication, col. 8, lines 21-24);

a media selecting unit for selecting media data to be delivered based on both a degree of media importance as a parameter assigned to each of said media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus (e.g. Data unit (as *media selecting unit*) stores and reads various data in accordance with instructions from control unit, col. 8, lines 30-31);

a transmission-data generating unit for generating metadata in which both address information indicating a location of said selected media data and presentation layout information indicating a presentation layout of said media receiving apparatus which is determined based on both the degree of media importance of said selected media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus are described (e.g. control console (as *transmission-data generating unit*) performs, through the operation of a user, the entry of various types of data or instructions enabling or preventing transmission of multimedia message , col. 7, lines 24-27);

a data transmitting unit for delivering said metadata to said media receiving apparatus by way of said network (e.g. control unit (as *data transmitting unit*) controls

interface unit to performs transmission and reception of data with external terminals, col. 8, lines 44-49); and

a media communication unit for delivering said media data in response to a request from said media receiving apparatus which has received said metadata (e.g. MMS user database server (as *media communication unit*) receives entry information of transmission destination and the designation of the format that is to be transmitted and determines whether the entry information that is to be transmitted can be received at transmission-destination, then transmit the content of the multimedia message to each of transmission destinations, col. 7-col. 8, lines 1-9).

Regarding claim 2, Shinohara further discloses the media delivering apparatus, characterized in that said apparatus comprises a importance change monitoring unit for changing said degree of media importance in response to a change indication for changing said degree of media importance, and for notifying the change in said degree of media importance to the media selecting unit, and characterized in that said media selecting unit selects the media data to be delivered based on both the changed degree of media importance and at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus, the transmission-data generating unit generates the metadata in which both the address information indicating the location of said selected media data which is selected based on both the changed degree of media importance and the presentation layout information indicating the presentation layout of said media receiving apparatus which is determined based on

both the changed degree of media importance of said selected media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus are described, and the data transmitting unit delivers said changed metadata (col. 6, lines 29-52).

Regarding claim 3, Shinohara further discloses the media delivering apparatus, characterized in that said apparatus comprises a importance change monitoring unit for changing said degree of media importance in response to a change indication for changing said degree of media importance, and for notifying the change in said degree of media importance to the media selecting unit, and characterized in that said media selecting unit selects the media data to be delivered based both the changed degree of media importance and at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus, the transmission-data generating unit generates a change command for changing the metadata which is generated before said degree of media importance is changed based on both the changed degree of media importance and at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus, and the data transmitting unit delivers said change command (col. 7, lines 22-50).

Regarding claim 4, Shinohara further discloses the media delivering apparatus, characterized in that the transmission-data generating unit describes metadata including synchronization information indicating a timing for switching between screen displays in

the media receiving apparatus in the metadata (col. 7, lines 23-39).

Regarding claim 5, Shinohara discloses the media delivering apparatus, characterized in that the transmission-data generating unit describes metadata including conditional branching information about at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus which are used for determining the presentation layout of the media receiving apparatus (col. 7, lines 1-21).

Claims 6 and 7 recite "media delivering apparatus" are similar to claims 1, therefore claims 6 and 7 are rejected by the same reasons.

Regarding claim 8, Shinohara discloses a media receiving apparatus which receives media data delivered thereto by way of a network, characterized in that 25 said apparatus comprises:

a data receiving unit for, based on both a degree of media importance as a parameter assigned to each of said media data and at least one of a communication capability of said network and a receiving capability of said media receiving apparatus as a parameter, receiving metadata in which both address information indicating a location of media data to be delivered and presentation layout information indicating a presentation layout of said media receiving apparatus are described (e.g. Wireless unit col. 8, lines 21-24);

a data analyzing unit for analyzing said metadata received by said data receiving unit (e.g. control console, col. 8, lines 24-27);

a real-time streaming protocol (RTSP) communication unit for making a request for delivery of said media data based on the address information described in said metadata analyzed by said data analyzing unit (e.g. interface unit, col. 8, lines 31-33);

a media receiving unit for receiving the media data delivered to said media receiving apparatus (e.g. Data unit, col. 8, lines 30-31); and

a media display unit for presenting the received media data based on the presentation layout information described in said metadata analyzed by said data analyzing unit (e.g. display unit, col. 8, lines 27-28).

Regarding claim 9, Shinohara further discloses the media receiving apparatus, characterized in that the data receiving unit receives a change command for changing the received metadata as the degree of media importance is changed, and the data analyzing unit interprets said change command received by said data receiving unit, and updates said received metadata (col. 7, lines 22-50).

Claims 10-18 recite "methods" are similar to claims 1-9, therefore claims 10-18 are rejected by the same reasons.

Response to Arguments

11. Applicant's arguments filed 10/21/2008 have been fully considered but they are not persuasive.

12. In response to applicant's argument on independent claims 1, 6 and 7:
Shinohara fails to teach or suggest "*a parameter acquiring unit for acquiring at least one of a communication capability of said network and a receiving capability of said media receiving apparatus as a parameter*". Base on the amended claims 1, 6 and 7, the claims have been re-interpreted (see rejections above). In additional, Shinohara's invention is a multimedia communication system in which a mobile telephone that originates transmission can detect the media types (*as a parameter*) and formats of a multimedia message that can be received by destination mobile telephones (see abstract).

For these reasons, this application is now considered. However, the teaching of Shinohara is still anticipated amended claims under 35 USC 102(e).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CECILE VO whose telephone number is (571)270-3031. The examiner can normally be reached on Mon - Thu (9AM - 5:00PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on 571-272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 15, 2008

/Cecile Vo/
Examiner
Art Unit 2169

/Tony Mahmoudi/
Supervisory Patent Examiner, Art Unit 2169